

REMARKS

Applicants have carefully considered the May 29, 2008 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-7 were pending in this application.

In response to the Office Action dated May 29, 2008, claims 2 and 5 have been canceled and claims 3, 4 and 6 have been amended. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed claims and disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, including page 12, line 24 through page 13, lines 7-15. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claim 1 was objected to because of an informality regarding the term "ratio". Applicants submit that the objection is moot since the term "ratio" has been replaced with "amount" as suggested by the Examiner.

Claims 2-4 were rejected under 35 U.S.C. § 112 for lack of proper antecedent basis. Applicants have amended the claims to address the Examiner's objections. Moreover, claim 5 has been amended for consistency. Accordingly, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. Therefore, it is respectfully submitted that the imposed rejection under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as being unpatentable over Tsukada et al. (U.S. Pat. No. 5,800,636, hereinafter "Tsukada"); Claims 1, 2, 6 and 7 were rejected under 35 U.S.C. § 102(b) as being unpatentable over JP 2001-189211 (hereinafter "JP '211"); Claims 1-4, 6 and 7 were rejected under 35 U.S.C. § 102(a) as being unpatentable over JP 2004-172469 (hereinafter "JP '469"); Claims 1, 2, 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsukada in view of JP '469 and further in view of JP '211; and Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '469 in view of Ochiai et al. (U.S. Pat. No. 4,820,338, hereinafter "Ochiai"). Reconsideration and withdrawal of the rejections are solicited in view of the foregoing amendments and the following remarks.

The Examiner has relied on the doctrine of inherency in each of the anticipation rejections predicated upon Tsukada, JP '211 and JP '469 to support the position that the references inherently teach the claimed coercive force of dependent claims 2 and 7. Applicants traverse. Applicants submit that the Examiner did not discharge the initial burden of establishing a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. § 102 for lack of novelty, and that the Examiner's reliance upon the doctrine of inherency is misplaced.

Independent claim 1 has been amended to recite a soft magnetic material comprising metal magnetic particles containing iron and oxygen. The amount of the oxygen contained in the metal magnetic particles is more than 0 and is less than 0.05% by mass. The metal magnetic particles have a coercive force of  $2.4 \times 10^2$  A/m or less. Insulating coated films surround the surface of the metal magnetic particles and the insulating coated films containing an oxide that is formed by subjecting the metal magnetic particles to phosphoric acid treatment.

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.

*In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323, (CCPA 1981). To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference. The Examiner did not discharge that burden of indicating where the coercive force value is disclosed or remotely in the applied prior art and has not established that this express limitation is inherently disclosed by any of Tsukada, JP '211 or JP '469.

Based upon the foregoing, Applicants respectfully submit that the Examiner did not discharge initial burden of establishing a prima facie basis to deny patentability to the subject matter under 35 U.S.C. § 102 for lack of novelty. Moreover, the Examiner has not established the requisite basis upon which to invoke the doctrine of inherency which requires certainty.

Moreover, independent claim 1 has been further amended to describe that the insulating coated films which surround the surface of the metal magnetic particles, contain an oxide that is formed by subjecting the metal magnetic particles to phosphoric acid treatment. See for example page 12 line 24 bridging to page 13 line 7 of the present disclosure. As described in the specification (numbered paragraphs [0033]-[0034] of the published application), the insulating coated film 20 is formed by subjecting the metal magnetic particles 10 to treatment with phosphoric acid and the insulating coated film 20 contains an oxide. As the insulating coated film 20 containing an oxide, oxide insulators such as manganese phosphate, zinc phosphate, calcium phosphate, aluminum phosphate, silicon dioxide, titanium dioxide, aluminum oxide, or zirconium oxide may be used in addition to iron phosphate containing phosphorus and iron. As further described in the specification, the insulating coated film 20 functions as an insulating

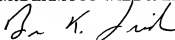
layer among the metal magnetic particles 10. By covering the metal magnetic particles 10 with the insulating coated film 20, the electric resistivity  $\rho$  of the dust core can be increased. Thereby, it is possible to suppress the flow of eddy current among the metal magnetic particles 10 to reduce the iron loss caused by the eddy current. Thus, the phosphoric acid treatment imparts significant properties to the claimed soft magnetic material. It is not apparent where any of the applied prior art discloses or suggests the insulating coated films of amended claim 1.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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